

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| First named inventor: Stephane Coulombe | Confirmation No.: 8150 |
| Serial No.: 10/765,576 | Group Art Unit: 2456 |
| Filed: January 26, 2004 | Examiner: Michael Young Won |

Title: Media Adaptation Determination for Wireless Terminals

MAIL STOP APPEAL BRIEFS--PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

REPLY BRIEF FOR APPLICANTS

Sir:

This is a reply brief in response to the Examiner's Answer of March 14, 2011.

For all of the reasons discussed below, it is the belief of the undersigned that the claims of the application distinguish the invention from the art relied on by the Examiner.

In the event that a proper request for an extension of time has not been requested, the Commissioner is hereby authorized to consider this a Petition for a conditional extension of time in order to maintain the pendency of the patent application so as to submit this response, and is also authorized to deduct any fee deficiency associated with the petition as well as any other fee deficiency, including fees related to extra claims, that has been inadvertently omitted, to deposit account number 230442.

REMARKS

Appellants file this Reply Brief to respond to several of the new issues raised by the Examiner's Answer of March 14, 2011.

In the "Response to Argument" section beginning on page 34, in section (a) the Examiner disagrees with appellants' argument that a person of ordinary skill in the art would understand "multimedia content" and "multimedia message" to have two different meanings. The Examiner provides several reasons for this disagreement.

First, it is noted that the Examiner argues that appellants provide no support for the position that a person of ordinary skill in the art would assign "multimedia message" a specific meaning that is distinct from "multimedia content". In response, appellants note that several of the references which have been cited by appellants in this application address multimedia messages. In these documents, it is clear that a "multimedia message" has a particular meaning in the art of wireless communication which relates to Multimedia Messaging Service (MMS) and Instant Messaging (IM), and that in this field of art, the phrase "multimedia message" does not refer to any and all types of media content. Rather, a "multimedia message" is a particular type of message comprising multimedia content, and is structured/formatted according to specific protocols for use in wireless communication. For example, appellants refer to the following references which were submitted to the Office on May 24, 2004: (1) 3GPP TS 22.140 V5.3.0 (2002-09), "3rd Generation Partnership Project; Technical Specification Group Services and System Aspects; Multimedia Messaging Service (MMS); Stage 1 (Release 5)"; (2) "MMS Conformance Document Version: 1.2", Open Mobile Alliance; (3) 3GPP TS 26.140 V5.1.0 (2002-06), "3rd Generation Partnership Project; Technical Specification Group Services and System Aspects; Multimedia Messaging Service (MMS); Media formats and codecs (Release 5)".

Appellants further note that this understood meaning of "multimedia message" is also set forth in the application as filed, on pages 1 and 2. Although the Examiner argues that to consider the claimed "multimedia message" in the manner set forth in the specification (and as understood by those having ordinary skill in the art) would be an improper importation of limitations from the specification into the claims, appellants respectfully disagree. Because the specification merely references how a person of ordinary skill in the art already interprets the phrase "multimedia message", it would not be importing a limitation from the specification to the claims. A person of

ordinary skill in the art reading the phrase “multimedia message” in the claim already understands it to have such a meaning, even without explicitly referring to, MMS for example, in the actual claim.

Second, it is the Examiner’s position that “[m]ultimedia content can include or comprise multimedia message and multimedia message can include or comprise multimedia content, and therefore can mean the same” (Examiner’s Answer, pages 34-35). The Examiner then references the types of media content taught by Mukherjee, and argues that this conclusion is supported by appellant’s own statement on page 4 of the Appeal Brief that “the present invention relates to the field of the multimedia adaptation (transcoding) of such a multimedia message, where one skilled in the art would appreciate that such multimedia messages form part of Multimedia Messaging Service (MMS), and Session Initiation Protocol (SIP), as a standard way to send messages that include multimedia content to and from mobile phones.”

While appellants acknowledge that a multimedia message, as the term is claimed and understood by persons having ordinary skill in the art, does include multimedia content, by no means does that necessarily mean that the opposite is true, that multimedia content comprises or includes multimedia messages, or that multimedia content and multimedia messages are the same. Although the Examiner asserts that appellants provide no support for its assertion that a “multimedia message” is distinct from “multimedia content”, the Examiner also points to no specific support for the proposition that “multimedia messages” and “multimedia content” are the same. There is no reference to Mukherjee, where Mukherjee states that the referenced “multimedia content” is or comprises, a “multimedia message.” The types of media referenced by the Examiner (streaming video, images, audio and animation, or combinations of them), do not comprise multimedia messages, nor does Mukherjee assert that they comprise multimedia messages.

The conclusion that “multimedia content” and “multimedia messages” are the same cannot be reached merely based on the fact that a multimedia message comprises multimedia content. The fact that a whole comprises individual parts, does not lead to the conclusion that one of the parts can comprise the whole or that they are the same thing. For example, a car comprises an engine, but that alone does not mean that an engine comprises a car, or that a car is the same thing as an engine, as it is clear that an engine can be a part of some other structure and that it

requires more than an engine to create a car. Thus, there is no clear basis for the Examiner's assertion that multimedia content and multimedia messages are the same, or that multimedia content comprises multimedia messages.

The Office then asserts that, even if the multimedia content/data of Mukherjee is not considered to be a "multimedia message", then Maes makes up for the deficiency because Maes discloses "voice, video and data conferencing over Internet Protocol (IP)", and "[v]ideo conferencing to one of ordinary skill in the art, is clearly considered multimedia messaging." Appellants respectfully disagree. As the term is used in the art, with reference made to the above cited documents, video conferencing is not multimedia messaging. The two utilize different formats and protocols, and video conferencing would not be considered to be "multimedia messaging" as that term was understood by persons having ordinary skill in the art at the time of appellant's invention.

Therefore, for the foregoing reasons, appellants respectfully disagree with the assertions set forth in section (a) of the Response to Arguments of the Examiner's Answer.

With respect to section (b) of the Response to Arguments, the Examiner disagrees with appellants' argument that it would not have been obvious to combine Mukherjee and Maes, on the grounds that the proper test for determining obviousness is "what the combined teachings of the references would have suggested to those of ordinary skill in the art." Appellants respectfully disagree with the assertion that the combination renders the claimed invention obvious, and maintains its earlier provided remarks on pages 13-14 of the Appeal Brief. Because the combination of Mukherjee and Maes would not necessarily have been operable, the references teach away from their combination. Thus, a person of ordinary skill in the art would not have even considered their combined teachings, nor would the combined teaching suggest the claimed invention.

In addition to those points raised in the Response to Arguments described above, appellants also note that the Examiner has raised new issues in the main rejections of the independent claims.

With respect to claim 1, the Examiner cites column 14, lines 3-21 of Mukherjee as also disclosing "a user terminal of the sending terminal inserting, into the multimedia message, media characteristics of the multimedia message sufficient in detail to enable determining whether the multimedia message should be

transcoded to accommodate multimedia capabilities of the receiving terminal.” Appellants respectfully disagree. First, this section of Mukherjee does not reference “multimedia messages” as claimed. In addition, although this passage of Mukherjee mentions that “transcoders 90 and 91 will provide formatted media data that is adapted to the receiving attributes of both of the receiving destinations 93 and 94 and transcoder 92 generates individual formatted media data bit-streams each adapted to the capabilities of one of receiving destinations 93 and 94”, this passage does not appear to teach or suggest “inserting, into the multimedia message, media characteristics of the multimedia message sufficient in detail to enable determining...”. There is no mention of inserting media characteristics (which the claim further recites are inserted into a field in the header portion of the message), sufficient to enable determining whether the multimedia message should be transcoded to accommodate multimedia capabilities of the receiving terminal. Rather, this passage merely states receiving attributes are provided to the transcoder and the data is formatted accordingly. There is not an insertion of media characteristics as claimed.

Further with respect to claim 1, it is now asserted by the Examiner that Mukherjee discloses “wherein the multimedia message has a header portion and a body portion, and the media characteristics of the multimedia message are inserted into a field in the header portion of the multimedia message,” with reference made to Figures 3A and 38, and column 7, lines 1-25. It was previously asserted that Maes taught this feature. Appellants respectfully disagree. As appellants have stated previously with respect to Mukherjee generally, this section of the reference does not mention “multimedia messages” as claimed.

Lastly with respect to claim 1, it is asserted that column 14, lines 3-21 of Mukherjee discloses “the messaging server reading the media characteristics of the multimedia message and deciding whether the multimedia message should be transcoded based only on a comparison of the inserted media characteristics of the multimedia message and actual or assumed multimedia capabilities of the receiving terminal.” Appellants respectfully disagree, because as discussed in reference to this portion of Mukherjee, there is no mention of multimedia messages, or of inserted media characteristics of a multimedia message.

Therefore, appellants respectfully disagree with the new issues raised by the Examiner in the rejection of claim 1.

To the extent that these new issues relate to the other independent claims 11, 12, 13, 21, 24, 27, 30, 33, 38 and 48, as well as the dependent claims, appellants respectfully disagree for the same reasons set forth with respect to claim 1.

Conclusion

For the reasons discussed above, appellants respectfully submit that the rejections of the Final Office Action and Examiner's Answer have been shown to be inapplicable, and respectfully requests that the Board reverses the rejections to pending claims 1-21, 24, 27, 30, 33, 36-38, 41, 42 and 48.

May 16, 2011

Date

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